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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application of: William R. Kennedy, et al. Art Unit: 3637
Serial No.: 10/003,353
Filed: November 1, 2001
Confirmation No.: 5231
For: MINE DOOR LEAF AND METHOD OF MANUFACTURE THEREOF
Examiner: Phi Dieu Tran A

June 10, 2005

REPLY BRIEF

This is a reply to the Examiner's Answer mailed May 18, 2005.

I. Amended Appeal Brief

Appellant submits herewith an Amended Appeal Brief. The Appeal Brief has been amended to include an Evidence Appendix and a Related Proceeding Appendix as required by 37 C.F.R. §41.37(c)(1)(ix) and (x), respectively. The added Appendices indicate that no evidence or information with regard to related proceeding is being submitted with the Appeal Brief.

In addition, the Appeal Brief has been amended to consistently refer to "appellant" (instead of appellants or applicants).

II. Grouping of Claims

The Answer incorrectly states that all of the claims stand or fall together. See page 2, paragraph 7. The statement is incorrect because the groups of claims presented in the Argument section of the brief and identified by subheadings A-E were properly set forth as separate subheadings and separately argued (see section VII of the brief). Appellant believes the brief is in accordance with the new appeal brief rules, specifically 37 C.F.R. 41.37(c)(1)(vii). Appellant respectfully points out that

37 C.F.R. 1.192, as cited by the Examiner, reflects the old appeal brief rules and has therefore been "Removed and Reserved."

III. Grounds of Rejection

The Examiner's Answer reasserts the § 103 rejection over Kennedy in view of Zen. The Examiner correctly asserts that Zen teaches that its improved frame structure provides increased strength and rigidity over previous frames (col. 1, lines 29-33). But Zen does not consider the foam insulation to be part of the frame. It is clear from reading the entirety of Zen that he did not recognize any strength function from his insulation. Zen does not state that the insulation adds strength, and in particular, his claims and his Summary of the Invention section do not even mention the insulation. If Zen relied on the insulation for added strength, he would have stated this as an advantage of the invention. Zen simply does not teach or suggest that a door is strengthened by foam insulation.

Assuming that the Examiner believes Zen's insulation inherently strengthens his door, there is no basis to reasonably support the determination that the recited strength characteristic necessarily flows from the teachings of the applied prior art. M.P.E.P. §2112 citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient for inherency. See M.P.E.P. §2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993). Zen is completely silent on how the insulation effects the strength of his door. Absent such information, the Office has no basis for maintaining that the insulation strengthens his door. It is entirely possible that Zen's insulation 1) has no effect on the strength of the door, or 2) weakens the door since the door is burdened by the additional weight of the insulation. Thus, the Examiner has not provided a rationale or evidence tending to show inherency.

Moreover, the Examiner must still provide some reason or suggestion for combining Zen with Kennedy. Appellant

respectfully submits there is no such reason or suggestion in Kennedy or Zen, and in fact there is a teaching away from the combination when one reads and understands both Kennedy and Zen. Kennedy says nothing about insulating his door, and it is therefore reasonable to assume that there is no need for insulation in a mine door. However, one of the objects of Kennedy is the provision of an improved mine door system that is lightweight yet sturdy and resistant to flexure (col. 1, lines 26-40). If one of ordinary skill were actually following the teachings of Kennedy, he would not add weight, in the form of foam insulation, as asserted in the rejection. (One might consider adding Zen's frame for strength, but such frame does not include the foam.) Kennedy does not teach adding insulation to a mine door. One of ordinary skill would not add foam insulation to strengthen the Kennedy door because Zen does not teach adding foam insulation for strength. Following Kennedy, one would be adverse to adding anything that did not strengthen the door, and Zen does not teach or suggest that his foam insulation does anything except insulate the door. So taken together, the references teach away from adding foam insulation. This analysis of the two references also reflects that the rejection is based on hindsight analysis. The Examiner has simply pieced together the invention from two disparate references. Accordingly, the rejection over Kennedy in view of Zen must fail.

Conclusion

In addition to the reasons set forth in appellant's Brief on Appeal, the rejections of the claims on appeal are in error for the reasons set forth above. Therefore, appellant requests that the Examiner's rejections of claims 1-9, 14 and 31-45 be reversed.

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Appellant does not believe that any fee is due. However, the Commissioner is hereby authorized to charge any deficiency or overpayment of any fees to Deposit Account No. 19-1345.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Michael G. Munsell".

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